REMARKS

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1-24 remain pending. Claims 1, 2, 11, 12, and 24 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Information Disclosure Statement

In the Office Action, the Examiner indicated that he did not consider the foreign patent documents supplied with the Information Disclosure Statement (IDS) filed September 29, 2006, alleging that "full translation is required to fully consider the prior art" and citing the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Applicants respectfully disagree. 37 CFR 1.98(a)(3)(ii) requires that Applicants submit "[a] copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c)." Applicants assert that submission of full translations of all the cited references is only required if such translations are readily available.

Applicants note that although the Examiner has indicated that he has not considered the foreign language patent documents submitted in the IDS of September 29, 2006, he has also maintained that the reference JP 04-172496 to Hiroshi (hereinafter "Hiroshi") allegedly discloses or renders obvious all of the claims, either under 35 U.S.C. § 102(b) or § 103(a). By the Examiner's own rationale, Applicants fail to understand how the Examiner has "fully considered" the Hiroshi reference based solely on the English-language abstract and the figures. Indeed, Applicants submit that Hiroshi does not disclose or render obvious the features of the instant invention, as outlined in this Reply, *infra*.

Nevertheless, through this reply Applicants have submitted a full translation of Hiroshi (JP 04-172496), as well as partial translations of JP 08-123658, JP 08-227341, and JP 2003-005946 indicating the relevance of these references as cited in the instant application. Applicants submit that the IDS meets the requirements of 37 CFR 1.97 and 1.98, as well as MPEP § 609, and respectfully request consideration of the references cited therein.

Claim Rejections - 35 U.S.C. §102

Claims 1-7, 10-12, 14-16, 19, and 24 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by JP 04-172496 to Hiroshi ("Hiroshi"). Applicants submit the Examiner has failed to establish a prima facie case of anticipation and traverse the rejection.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the cited reference must teach or suggest each and every element in the claims. *See M.P.E.P. §2131; M.P.E.P. §706.02.* Accordingly, if the cited reference fails to teach or suggest one or more claimed elements, the rejection is improper and must be withdrawn.

Independent claim 1 recites, *inter alia*, a screen displaying a moving picture icon which continues to move while being selected, wherein *the electronic apparatus acquires icon image information of said selected icon from a storage for icon image information, processes the information, and generates information concerning a group of icon images displayed at the time of selection including a plurality of different new icon image information.*

Hiroshi discloses a device for dynamically displaying icon animation by high-speed switching of icon image data stored frame-by-frame. Hiroshi disclose that a detection means detects when a cursor is caused to go into or leaves from an icon area being displayed on a screen. When the cursor is detected as entering an icon area, a display switching means displays the content in the icon area by switching the images stored frame-by-frame to display an animated icon. *See page 2, lines 14-31.* In general, Hiroshi describes a conventional method for generating animation whereby multiple image frames, all stored in storage, are displayed in rapid succession.

In contradistinction, according to the features of claim 1 the electronic apparatus acquires icon image information of a selected icon from a storage for icon image information, processes the information, and then generates information concerning a group of icon images displayed at the time of selection including a plurality of different new icon image information. In other words, the present invention acquires icon image information according to a selected icon, and then processes the information and generates different new icon information. This generated information relates to the group of icon images displayed at the time of the selection. In this manner, the apparatus of the present invention may only store one image in memory, i.e., a static

icon image displayed when the icon is not selected, and generate new icon information to display as a moving picture icon while the icon image is selected. One desirable effect of such an apparatus is the potential to save memory space by not requiring that all of the frames of the icon animation be stored in the memory.

Applicants respectfully submit that Hiroshi fails to disclose generating information concerning a group of icon images displayed at the time of selection including a plurality of different new icon image information, as recited in claim 1. Hiroshi clearly redraws the display in the icon area by accessing the plurality of frames of the icon animation from storage. Additionally, Hiroshi expressly discloses that the animation of the icon is achieved "by high-speed switching of image data *stored frame-by-frame*" (*p.2, lines 16-17, emphasis added*). As Hiroshi clearly states that all of the frames of the image data for the icon animation are stored in memory, Applicants respectfully submit that Hirsohi cannot disclose the features of the present invention and in fact *teaches away* from the present invention.

Therefore, at least because Hiroshi fails to teach or suggest each and every claimed element, independent claim 1 is distinguishable from the prior art. Independent claims 2, 11, 12, and 24 recite features including at least a feature comparable to that of claim 1 regarding the generation of information concerning the group of icon images displayed at the time of selection that includes a plurality of different new items of icon image information, and are likewise distinguishable from Hiroshi at least for the reasons presented above with respect to independent claim 1. Dependent claims 3-10 and 13-23 are also distinguishable from the prior art at least due to their dependence from claims 1, 2, 11, 12, and 24, directly or indirectly. Accordingly, Applicant respectfully requests that the rejection of claims 1-24 under 35 U.S.C. § 102(b) be withdrawn.

Claim Rejections - 35 U.S.C. §103(a)

Claims 8, 9, 13, 17, 18, and 20-23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hiroshi. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and traverse the rejection.

For a 35 U.S.C. § 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142.* One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j).* Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, the Examiner has conceded that the Hiroshi reference does not disclose at least the features of dependent claims 8, 9, 13, 17, 18, and 20-23, and makes general allegations that these features would have been an obvious matter of design choice in view of the Hiroshi reference, *Ex Parte Smith*, and the *KSR v. Teleflex* decision. Applicants respectfully disagree, first on the grounds that the Examiner has failed to provide evidentiary support of the features of these claims in the prior art, and second on the grounds that even should such features be somehow taught in the prior art, which Applicants do not concede and which the Examiner has not shown, the Examiner has failed to provide sufficient rationale or an explanatory basis for alleging that these features would somehow be obvious to one of ordinary skill in the art to incorporate into the device disclosed by Hiroshi. Merely alleging "design choice" without providing prior art teaching the feature in question or providing a rationale for the "design choice" amounts to a general allegation of Official Notice. As the Examiner has conceded that Hiroshi fails to disclose the features of these claims, and as the Examiner has not provided a teaching of these features, Applicants respectfully submit the Examiner has not made a *prima facie* case of obviousness against these claims. Additionally, claims 8, 9, 13, 17, 18, and 20-23 are patentable due to their dependence from patentable independent claims 1, 2, 11, 12, and 24, discussed above.

Applicants submit that claims 8, 9, 13, 17, 18, and 20-23 are patentable over Hiroshi and respectfully request that the rejection of claims 8, 9, 13, 17, 18, and 20-23 under §103(a) be withdrawn.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John R. Sanders, Reg. No. 60,166 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: August 15, 2008

Respectfully submitted,

By _____

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